

No.10113.A06  
PAT00018.A06

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES

Applicants : Paul S. GLOYER et al.

Appl. No. : 09/802,760

Filed : March 8, 2001

For : POLYURETHANE ELASTOMERS AND SHAPED  
ARTICLES PREPARED THEREFROM

Examiner Rachel F. Gorr  
Technology Center 1700  
Group Art Unit 1711  
Confirmation No. 8217

**REPLY BRIEF**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This Reply Brief addresses the arguments of the Examiner, as presented in the three substantive paragraphs of Section (11) in the December 3, 2003 Examiner's Answer.

In the Appeal Brief, U.S. Patent No. 5,286,570, U.S. Patent No. 4,729,925, and European Patent Application No. 0 604 334 are referred to, respectively, as SCHLUETER, JR. et al., CHEN et al. and RAMOS et al. For clarity of expression, in this Reply Brief these patent publications are identified simply as SCHLUETER, CHEN, and RAMOS.

First Paragraph in Section (11)

It is respectfully submitted that, in the first paragraph of this Section (11), the Examiner incorrectly states Appellants to be arguing that the SCHLUETER Example II polyisocyanate

prepolymer has too much diisocyanate, for this SCHLUETER Example II to be teaching Appellants' recited 45-70 weight percent polyisocyanate prepolymer. Appellants' argument is not that there is too much diisocyanate in the polyisocyanate prepolymer of SCHLUETER Example II; rather, Appellants are arguing that there is too much diisocyanate in Mix A of SCHLUETER Example II.

Specifically, there is too much of the diisocyanate, in Mix A, to be able get enough polyisocyanate prepolymer to reach Appellants' 45 weight percent lower limit. Because of how much excess diisocyanate there is in Mix A, reaching this 45 weight percent amount is physically impossible.

The Appeal Brief "new calculation", referred to by the Examiner, proves that even under completely idealized conditions, SCHLUETER Example II cannot provide more than 18.78 weight percent polyisocyanate prepolymer. And also, in the Appeal Brief it is shown how the art demonstrates the significance of the difference between the idealized SCHLUETER Example II 18.78 weight percent, and Appellants' recited 45 weight percent lower limit.

The Examiner also argues, as supporting her position on this issue, that Appellants' claims don't specify how their prepolymer is made, what NCO content it has, or what its molecular or equivalent weight is. It is respectfully submitted that the foregoing is true, but irrelevant. Appellants are not arguing these features here.

Rather, in the Appeal Brief, Appellants point out that, to provide the maximum weight percent of polyisocyanate prepolymer, as high as possible a proportion of the diisocyanate must be reacted; and to get as high as possible a proportion of the diisocyanate reacted, the result must be nothing but diisocyanate endcapped triblock polyisocyanate prepolymer. And even this idealized result can only provide an 18.78 weight percent maximum of polyisocyanate prepolymer, which is far below the 45 weight percent lower limit as specified in all of Appellants' claims under appeal.

Second Paragraph in Section (11)

It is respectfully submitted that, in the second paragraph of Reply Brief Section (11), the Examiner is still incorrectly addressing the issue of motivation. The burden is on the Examiner to show the motivation for combining the reference teachings.

As to the matter of motivation, the Examiner refers to the ability, of one skilled in the art, to recognize that the CHEN et al. and RAMOS charge control agents will not migrate because of their attachment. But such recognition does not provide the motivation to modify the SCHLUETER elastomer, by replacing its charge control agents with those of CHEN and RAMOS.


Third Paragraph in Section (11)

The Examiner still fails to dispute the point that RAMOS does not supply the deficiencies of the references.

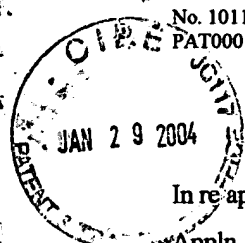
Conclusion

For the reasons stated herein, as well as for the reasons stated in the Appeal Brief, Appellants submit that the rejections should be reversed.

Respectfully submitted,  
Paul S. GLOYER et al.

  
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January 29, 2004  
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In re application of : Paul S. GLOYER et al.

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Sir:

Transmitted herewith are the following:

☒ Reply Brief

☐ Terminal Disclaimer

☐ Request for Extension of Time for 1 Month

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The fee has been calculated as shown below:

Claims After Amendment	No. Claims Previously Paid For	Present Extra	Small Entity		Other Than A Small Entity	
			Rate	Fee	Rate	Fee
Total Claims: 47	48*	0	x 9=		x 18=	\$0.00
Indep. Claims: 6	6**	0	x 43=		x 86=	\$0.00
Multiple Dependent Claims Presented			145=		290=	\$0.00
			Total:		Total:	\$0.00

\*If less than 20, write 20

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